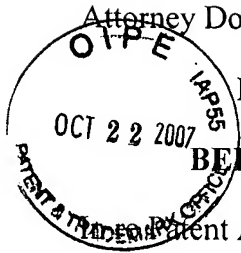Attorney Docket No. 30014200-1057

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

OCT 2 2 2007

In re Patent Application of	) Group Art Unit 2167
	)
Brian HOLTZ et al.	) Examiner: Mohammad Ali
	)
Application No. 10/021,943	)
	)
Filed: December 12, 2001	)
	)
For: METHOD AND SYSTEM FOR	)
COMPARING AND UPDATING	)
FILE TREES	)

Mail Stop Appeal Brief-Patent
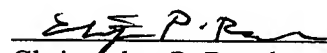Commissioner for Patents
Alexandria, VA 22313-1450

REPLY BRIEF ON APPEAL

Dear Sir:

Appellants submit herewith Appellants' Reply Brief on Appeal under 37 C.F.R. §41.41 in response to the Examiner's Answer mailed on August 16, 2007.

The Commissioner is hereby authorized to charge any deficiency in fees associated with this communication or credit any overpayment to Deposit Account No. 19-3140. A duplicate copy of this sheet is enclosed.

Respectfully Submitted,

_____ (Reg. No. 45,034)
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SONNENSCHEIN NATH & ROSENTHAL LLP
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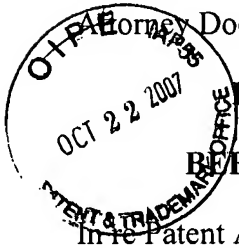Attorneys for Appellants

Application No. 10/021,943
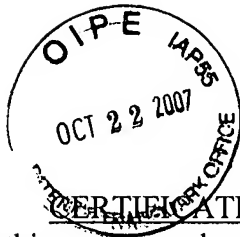
CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited as First Class Mail in an envelope addressed to Mail Stop Appeal Brief-Patens, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on October 16, 2007.

_____ (Reg. No. 45,034)
Christopher P. Rauch

- 2 -

Attorney Docket No. 30014200-1057

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REPLY BRIEF ON APPEAL

Dear Sir:

In accordance with the provisions of 37 C.F.R. §41.41, Appellants submit this Reply Brief on Appeal in response to the Examiner's Answer mailed on August 16, 2007. Appellants respectfully submit that the Examiner's assertions are incorrect as a matter of fact and law. Thus, for the reasons set forth below, Appellants respectfully request that this Board reverse the rejection of claims 1, 2, 4-6, 9, 10, 12-14, 17, 18 and 20-22 under 35 U.S.C. §103.

I.   <u>STATUS OF CLAIMS:</u>

Claims 1, 2, 4-6, 9, 10, 12-14, 17, 18 and 20-22 are pending in the application.

Claims 1, 2, 4-6, 9, 10, 12-14, 17, 18 and 20-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Michael Man-Hak Tso* (U.S. Patent No. 5,706,509, hereinafter "*Tso*") in view of *Multer et al.* (U.S. Patent No. 6,925,476, hereinafter "*Multer*").

The present appeal is directed to claims 1, 2, 4-6, 9, 10, 12-14, 17, 18 and 20-22, which were finally rejected in an Office Action dated August 24, 2006.

A listing of the claims 1, 2, 4-6, 9, 10, 12-14, 17, 18 and 20-22 appears as the Claims Appendix of Appellants' Main Brief on Appeal.

II.   GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL:

The ground of rejection to be reviewed on appeal is as follows:

Claims 1, 2, 4-6, 9, 10, 12-14, 17, 18 and 20-22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Michael Man-Hak Tso* (U.S. Patent No. 5,706,509, hereinafter "*Tso*") in view of *Multer et al.* (U.S. Patent No. 6,925,476, hereinafter "*Multer*").

III.   ARGUMENT:

Claims 1, 2, 4-6, 9, 10, 12-14, 17, 18 and 20-22 stand rejected under 35 U.S.C. §103 by the Examiner as being rendered obvious based on various references. As set forth more clearly below, the rejection of the claims set forth by the Examiner under 35 U.S.C. §103 is improper and accordingly the Board should reverse this rejection.

Claims 1, 2, 4-6, 9, 10, 12-14, 17, 18 and 20-22 are not rendered obvious under 35 U.S.C. §103(a) based on the teachings of *Tso* in view of *Multer*

Appellants respectfully submit that the Examiner's assertions are incorrect as a matter of fact and law. Thus, for the reasons set forth below, Appellants respectfully request that this Board reverse the rejection of claims 1, 2, 4-6, 9, 10, 12-14, 17, 18 and 20-22 under 35 U.S.C. §103(a) as being unpatentable over *Tso* in view of *Multer*.

A.   *Tso* in view of *Multer* fails to teach or suggest replacing a creation operation and a deletion operation with a reparent operation

The term reparent operation is clearly understandable in the specification and claims. The Examiner alleges that the term reparent operation is unclear within both the specification and the claims. Appellants disagree.

The specification clearly describes that a "parent" node "is any node [of a tree] that has a branch leading down to one or more lower nodes." *Specification* [0009]. The specification further describes that various operations may be performed on the tree, such as create, delete, modify, rename, and reparent operations. *Specification* [0038]. The specification further describes that a trivial "rename" operation are those that occur without reparenting. *Specification* [0038]. Thus, one having skill in the art would clearly understand that a reparenting operation relates to assigning a different parent to a sub-branch of one or more lower nodes.

This subject matter is simply neither taught nor suggested by *Tso* and *Multer*, taken singly or in combination. The Examiner argues that *Tso's* operations of merging and synchronizing change lists, truncating change lists, and recording operations teaches a reparenting operation. *Examiner's Answer*, page 7. However, these operations are clearly unrelated to reparenting. These operations from *Tso* fail to teach or suggest assigning a different parent to a sub-branch of one or more lower nodes.

Further, this claimed subject matter is not inherent in *Tso*. To establish inherency, a reference "must make clear that the missing descriptive matter is necessarily present in the thing

described in the reference, and that it would be so recognized by persons of ordinary skill." . . . "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re* Robertson, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950 (Fed. Cir. 1999). *Tso* describes generally that lists can be synchronized and merged. To merge and synchronize lists, *Tso* may use a variety of mechanisms. For example, *Tso* may delete nodes. Thus, reparenting by assigning a different parent to a sub-branch of one or more lower nodes is not necessarily present in *Tso*, let alone replacing a creation operation and a deletion operation with a reparent operation. *Tso* simply does not necessarily replace a creation operation and a deletion operation with a reparent operation. Accordingly, it is incorrect to assume that this is inherently found in *Tso*.

Further, Appellants respectfully disagree with the Examiner's interpretation of the term "reparenting operation." The Examiner alleges that a reparenting operation "is accomplished by keeping only the operations that describe the differences between the files and are efficient in transforming the first file structure to the second file structure, such as create, delete, etc." *Examiner's Answer*, page 7. Appellants disagree. As described above, a reparenting operation is not a create or delete operation. Further, as described above, a reparenting operation relates to assigning a different parent to a sub-branch of one or more lower nodes.

Accordingly, *Tso* in view of *Multer* fails to disclose or suggest replacing a creation operation and a deletion operation with a reparent operation.

B. *Tso* does not inherently disclose or suggest recursively walking a first file structure

The Examiner provides no support for *Tso* recursively walking a first file structure. To establish inherency, a reference "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." . . . "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re* Robertson, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950 (Fed. Cir. 1999). *Tso* describes generally that changes are identified in data sets. However, there are many ways that these changes may be identified. For example, *Tso* may look at timestamps, metadata, only particular nodes, or not use recursion. Thus, *Tso* simply does not necessarily recursively walk a first file structure. Accordingly, it is incorrect to assume that this is inherently found in *Tso*.
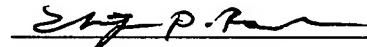
-7-

Further, it is improper to argue that this subject matter is implicitly disclosed in *Tso*. Nowhere does *Tso* mention walking a file structure, let alone recursively walking a file structure. And there is simply no suggestion in *Tso* to do so. This subject matter is not addressed in *Tso*. Appellants submit the Examiner has used impermissible hindsight, and has provided no support from *Tso*, to allege that *Tso* implicitly suggests recursively walking a file structure.

Appellants respectfully request that the Board reverse the rejection.

VIII. CONCLUSION:

For the foregoing reasons, Appellants respectfully submit that the rejection posed by the Examiner is improper as a matter of law and fact. Accordingly, Appellants respectfully request the Board reverse the rejection of claims 1, 2, 4-6, 9, 10, 12-14, 17, 18 and 20-22.

Respectfully submitted,

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